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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,459	11/21/2003	Terry L. Harris		4149

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EXAMINER

GOTTSCALK, MARTIN A

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,459

Applicant(s)

HARRIS, TERRY L.

Examiner

Martin A. Gottschalk

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04-18-2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 03/31/05. New claims 11-16 remain pending. Original claims 1-10 have been canceled.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 11-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, the recitation of a "computer-implemented method" in the preamble(s) is not sufficient to render the claims statutory, since there is no reference to a computer or computer-related elements within the respective bodies of the claims.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao (US Pat# 6,283,761, hereinafter Joao).

A. As per claim 11, Joao discloses a computer implemented (Joao: Fig. 1) method of operating a health-care service comprising (Joao: col 12, lns 21-26):

accepting an initial contact from a potential consumer seeking health service information (Joao: col 18, lns 32-36; Fig. 1, item 40, consumer reads on "patient")

analyzing and recording health-care necessities of potential consumer (Joao: col 17, lns 31-59, reads on "treatment analysis, diagnosis analysis".),

securing initial commitment from potential consumer for seeking health-care service provider in relation to consumer's necessities (Joao: col 32, ln 15. The

Examiner considers "...the requesting party can enter his request...and provide contact information" to be a form of securing an initial commitment),

finding and recording health-care service data generally in relation to consumer's necessities (Joao: col 32, Ins 20-27),

presenting health-care service data to consumer for consumer to analyze (Joao: col 32, Ins 28-35),

placing consumer in direct negotiation position with health-care service provider for consumer to secure contract with most convenient provider (Joao: col 32, Ins 34-37).

B. As per claim 12 Joao discloses a computer implemented method of operating a health-care service as described in Claim 11, wherein:

said health-care service data comprises medical care data and hospital care data (Joao: col 2, In 65 to col 3, In 2).

C. As per claim 13, Joao discloses a computer implemented method of operating a health-care service as described in Claim 12, further comprising:

placing a consumer in direct negotiating position with an insurance company having a suitable indemnity product (Joao: col 32, Ins 34-37; col 3, Ins 7-12).

D. As per claim 14, Joao discloses a computer implemented method of operating a health-care service as described in Claim 13, wherein:

step of analyzing and recording health-care necessities of potential consumer include data particularly related to the

geography preferences of consumer (Joao: col 31, Ins 25-31, reads on "...locations...of the above goods..."),

religious choices of consumer (Joao: col 12, Ins 58 to col 13, Ins 7, reads on "...individual and/or professional who can provide...wellness-related services...". The Examiner notes that members of the clergy are professionals who can provide wellness-related services.)

family needs of consumer (Joao: col 31, Ins 45-50. The Examiner considers finding "payers" – i.e. providers of insurance - to be a form of family need.), and

travel consequences of consumer (Joao: col 31, Ins 25-31. The Examiner considers the location of goods etc. to be an example of travel consequences, i.e. how far the consumer would have to go to pick up what was purchased.).

E. As per claims 15 and 16, Joao discloses a computer implemented method of operating a health-care service as described in Claims 11 and 14 respectively wherein:

presenting health-care service data to consumer includes establishing point of reference components for various health-care services (Joao: col 33, Ins 38-42. The Examiner considers being provided data to "...compare available policies..." as establishing a point of reference.).

Response to Arguments

3. Applicant's arguments in the response filed 3/31/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the REMARKS section of the response filed 3/31/05.

A. On page 5 of the response, Applicant argues that the applied Joao reference does not disclose an invention identical to Applicant's invention.

In response, the Examiner respectfully submits that the prior art meets the limitations as they are claimed as demonstrated by the passages cited by the Examiner in the prior office action and that Applicant makes no specific argument to the contrary (see item D, below).

B. On page 6 of the response, Applicant points out that the claims of the Joao patent recite an improvement, then goes on to state that the invention of Joao "...is actually restricted...to the specific 'improvement' described therein," and concludes "...that all other comments expressed in Joao are strictly excess verbiage, and not actual description of his invention."

In response, Applicant must realize that should an applied reference be a patent, in addition to pre-dating the current application sufficiently, the reference need only disclose the limitations claimed in the current application in order to anticipate the limitations; the patent reference is not required to claim the same limitations as those claimed in the current application (indeed, it should be noted more generally that a reference need not be a granted or issued patent at all, thus obviating the issue of

claimed material altogether). Thus in the present case, the Examiner is not constrained to applying only the material claimed by the Joao reference, but may draw from all of the material disclosed by the reference. Furthermore, the recitations of the reference's claims – such as the fact they are directed to an improvement - do not limit the portion of the overall material disclosed by the reference that may be applied in rejecting the current application's claims.

C. On page 7 of the response, the first and fifth paragraphs in particular, Applicant seems to be indicating that in spite of the specific passages from the Joao reference cited by the Examiner, the material disclosed by Joao is somehow too broad to apply to the claims of the current application.

In response, the Examiner notes that beyond these implications, Applicant fails to point to any specific examples of passages cited or explanations provided by the Examiner where this is the case (see item D below). The Examiner further notes that the breadth of both the original and amended claims of the current application are themselves quite broad, and respectfully submits that the applied Joao reference appropriately matches the scope of the claimed limitations.

D. On page 7 of the response, final paragraph, Applicant states the Joao reference is "...completely different from the Applicant's invention...".

In response, the Examiner notes that Applicant does not point to any specific distinction(s) between the features disclosed in the Joao reference and the features that

are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant's recited "system for establishing health care services" and the cited elements of the Joao reference? Further note that arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MG
07/02/2005



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